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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,558	04/07/2005	Mitsuru Takei	265706US0XPCT	8827
22850 7590 11/30/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ROBERTS, LEZAH	
			ART UNIT	PAPER NUMBER
			1614	
			NOTIFICATION DATE	DELIVERY MODE
			11/30/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

**Office Action Summary**

Application No.

10/530,558

Applicant(s)

TAKEI ET AL.

Examiner

Lezah W. Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This Office Action is in Response to the Amendment filed September 10, 2007.

All previous rejections have been withdrawn unless state below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This Action is made Non-Final.

### *Claims*

#### **Claim Rejections - 35 USC § 112 – Written Description (New Rejection)**

Claims 8-10 and 12-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1) The claims recite the limitation "a coating composition having a viscosity at 30°C of 300cP through 50,000 cP and including at least on monomer (d) and at least on photopolymerization initiator (e)...a surface smoothing composition...one polyfunctional monomer (f)".

The appearance of mere indistinct words in a specification or a claim (here the word "monomer"), even an original claim, does not necessarily satisfy the written description requirement. The disclosure must allow one skilled in the art to visualize or

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recognize the identity of the subject matter purportedly described. Univ. of Rochester v. G.D. Searle, 69 USPQ2d 1886, 1892 (CAFC 2004). Based on the instant claims reciting a photopolymerization initiator for each composition, the monomers appear to be photopolymerizable monomers yet the claim recites "monomer" that may encompass "any monomer" and not just those that are photopolymerizable. In the case of the smoothing composition, the monomer (f) "includes" monomers having three or more olefin double bonds but does not disclose examples of what this encompasses such as the structure, the size, what other groups may be included on the monomer, what other types of monomers are included or if the monomer is photopolymerizable. In regards to the coating composition, it appears the "monomer" is a hydrophilic, hydrophobic monomer or a mixture of the two. The examples of the hydrophilic monomer include methacrylic based monomers with a solubility at 25°C of 10 weight % or more and the hydrophobic monomers are esters with a solubility at 25°C of 10 weight % or less. The specification does not give other examples of hydrophilic monomers or hydrophobic monomers to support the term "monomer" nor does it disclose if the monomers are photopolymerizable monomers considering a photopolymerization initiator is included in the composition.

2) The claims recite the limitation "at least one acidic monomer". The instant specification discloses the acidic monomer comprises an acidic group "such as a phosphoric group, a pyrophosphoric group, a thiophosphoric group, a carboxylic group or a sulfonic group and also has a polymerizable unsaturated group such as an acryloyl

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group, a methacryloyl group, a vinyl group or a vinylbenzyl group. In particular, the monomers have an acryloyl group or a methacryloyl group as the unsaturated group is preferred." Although the specification gives specific examples of acryloyl group or a methacryloyl comprising monomer, it does not disclose examples of other monomers or indicate what other types of monomers are acidic monomers other than the four classes disclosed above. It also does not disclose monomers comprising several acidic groups or indication how one would determine how many acidic groups are encompassed by "at least one acidic group".

Claims 8-10 and 12-15 are rejected.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts  
Patent Examiner  
Art Unit 1614



Frederick Krass  
Primary Examiner  
Art Unit 1614

